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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,957

08/11/2005

David John Hughes

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02/19/2010

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EXAMINER

SZNAIDMAN, MARCOS L

ART UNIT

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1612

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/517,957
Filing Date: August 11, 2005
Appellant(s): HUGHES ET AL.

Mark D. Jenkins
For Appellant

EXAMINER'S ANSWER

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

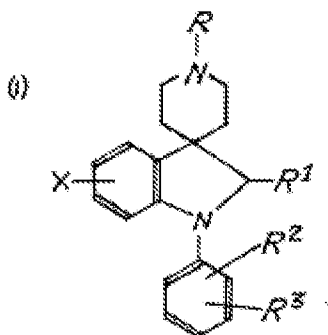
GB 1,603,030	Hoechst	11-1981
US 3,959,475	Bauer et al.	5-1976

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoechst (GB 1603030, cited in prior Office Action) in view of Bauer et. al. (US 3,959,475).

Hoechst teaches compounds of general formula I:



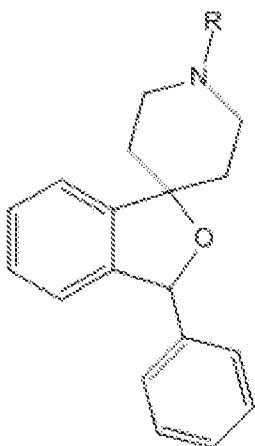
Wherein the R group, directly attached to the piperidine nitrogen, may be “alkenyl” (see page 1, lines 10-12). The reference further demonstrates that “allyl” (-

Art Unit: 1612

CH₂-CH=CH₂) is an example of an “alkenyl” moiety (page 7, line 16). These compounds are useful as antidepressants/ tranquilizers (see page 2, lines 9-10).

The primary reference (Hoechst) differs from the instant claims insofar as it does not disclose “phenylallyl” (-CH₂-CH=CH-Ph) as an example of the R “alkenyl” group required by the instant claims.

However, the secondary reference (Bauer) teaches that for compounds having similar cores to the primary reference:



and identical pharmaceutical activity: antidepressants/ tranquilizers (see abstract) , the allyl and phenylallyl groups, attached to the piperidine nitrogen like in the primary reference, are functional equivalents (see compound 105 on Table VII, columns 17 and 18 for R = “allyl”; and see compound 110 on Table VII, columns 17 and 18 for R = “phenylallyl”)

One skilled in the art would understand the term “alkenyl” as broadly suggested by the primary reference to include phenylallyl, given its close structural similarity to the allyl moiety specified therein, and further based on its the art recognized functional

Art Unit: 1612

equivalency of the two moieties provided by the secondary reference., thus resulting in the practice of claims 8 and 11-14 with a reasonable expectation of success.

Claim 10 further limits claim 8, wherein a composition comprises an insecticidally, acaricidally or nematocidally effective amount of formula IK.

According to the specification (see page 90, lines 17-19), an insecticidally, acaricidally or nematocidally effective amount is defined as: a composition that comprises by weight 0.0001% to 95%, more preferably 1% to 85%, for example 5 to 65% of active ingredient.

For claim 10, Hoechst further teaches (see page 7, lines 31-39) that these compounds can be part of a composition or preparation further comprising diluents, carriers, etc.; and that the preparations should contain at least 0.5% of active compound, which reads on the weight concentration of the instant application (0.0001% to 95%).

The statement in claim 10: “an insecticidal, acaricidal or nematocidal composition” is considered an intended use and does not add any new limitation to the claim.

Catalina Mktg. Int'l, Inc. V. Coolsavings.com, Inc., 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (fed. Cir. 2002). “The recitation of a new intended use for an old product does not make a claim to that old product patentable.” In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

(10) Response to Argument

First, Appellants argues that the compounds disclosed by Hoechst and Bauer have a different utility (antidepressants and tranquilizers) than the compounds of the instant application (insecticides, acaricides, molluscicides and/or nematocides) (see pages 7 and 8 of the Appeal Brief)

The Examiner is not persuaded by this argument; the utility disclosed by Bauer is the same or similar to the utility disclosed by Hoechst (antidepressants and tranquilizers), and since the compounds of both references have similar structures, it will be obvious to the skill in the art to combine the teachings of both references and arrive to the instant compounds with the motivation of making compounds with tranquilizing or antidepressant properties. The motivation (similar structures and same pharmacological properties: tranquilizers and antidepressants) to combine the above references (Hoechst and Bauer) in order arrive at the same or similar compounds disclosed by the instant application can be different from the one disclosed by Applicant (i.e. insecticide, acaricide, etc.). See MPEP 2144 section IV that states: "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggests the combination to achieve the same advantage or result discovered by Applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)". In other words, the fact that either the Hoechst or Bauer references disclose compounds with a different utility than the compounds instant application is not

Art Unit: 1612

necessary to establish a case of obviousness. What is relevant is that both the Hoechst and Bauer references disclose similar compounds with the same utility (i.e. tranquilizers and antidepressants), and as such there is a strong motivation to combine them.

Second, Appellant argues that the compounds disclosed by Bauer are structurally very different from those of the instantly claimed compounds (see page 9 of the Appeal Brief)

The Examiner disagrees; although the structures disclosed by Bauer and the instant application have some dissimilarities as pointed by Appellant, the fact is that Bauer still teaches that in a structurally close related family of compounds the allyl and phenyl allyl substituents are functionally equivalents in term of retaining the biological activity (i.e. tranquilizers and antidepressants) when they are attached to the nitrogen of the piperidine ring.

Third, Appellant argues that the person of ordinary skill would never realistically combine the disclosure of Hoechst with that of Bauer in order to prepare insecticidal compounds. The disclosures of these documents relate to totally different technologies. The relevant person of ordinary skill in the art would be a chemist working in the field agrochemical research. He would have no reason to suppose that the compounds of Hoechst would have any insecticidally useful properties. In fact, the person of ordinary skill, contemplating the teaching of Hoechst, would be taught away from the compounds of the present invention. The fact that the compounds of Hoechst are disclosed as

Art Unit: 1612

psychoactive in mammals would motivate the skilled person to avoid such structures as potential insecticides.

The Examiner is not persuaded; the utility disclosed by of Bauer is the same or similar to the utility disclosed by Hoechst (antidepressants and tranquilizers), and since the compounds of both references have similar structures, it will be obvious to the skill in the art to combine the teachings of both references and arrive to the instant compounds with the motivation of making compounds with tranquilizing or antidepressant properties. Again, the motivation (similar structures and same pharmacological properties: tranquilizers and antidepressants) to combine the above references (Hoechst and Bauer) in order arrive at the same or similar compounds disclosed by the instant application can be different from the one disclosed by Applicant (i.e. insecticide, acaricide, etc.).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/MARCOS SZNAIDMAN/

Examiner, Art Unit 1612

Art Unit: 1612

Conferees:

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612

/Robert Wax/

Supervisory Patent Examiner, Art Unit 1615